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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,013	02/19/2004	Frank Venegas JR.	IDS-14503/14	4303

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EXAMINER

HOGE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,013

Applicant(s)

VENEGAS, FRANK

Examiner

Gary C Hoge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

1. The Office action mailed October 21, 2004 was inadvertently directed toward the originally-filed claims, and did not take into account the preliminary amendment. That action is hereby vacated in favor of this supplemental action.

Specification

2. The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Caulkins.

Caulkins discloses a cover that could be used to cover a tubular metal guard rail of the type described. The cover is made of plastic, which is inherently polymeric because *The American Heritage Dictionary of the English Language*, Fourth Edition, defines “plastic” as “any of various organic compounds produced by polymerization . . .” The cover has an outer surface and an internal cavity 30 that terminates in a planar bottom edge adjacent the ground.

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Regarding claims 9 and 10, see Figs. 1 and 3. Also regarding claim 10, it is not known whether the letters were produced by a process using a stencil, but it is noted that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

5. Claims 8, 9 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Gildea.

Gildea discloses a cover that could be used to cover one or more of the ends of a tubular metal guard rail of the type described. The cover is made of plastic, which is inherently polymeric because *The American Heritage Dictionary of the English Language*, Fourth Edition, defines "plastic" as "any of various organic compounds produced by polymerization . . ." The cover has an outer surface and an internal cavity 30 that terminates in a planar bottom edge adjacent the ground.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caulkins in view of Hathorn.

Caulkins discloses the invention substantially as claimed, as set forth above. However, the message disclosed by Caulkins is not a lighted message. Hathorn teaches that it was known in the art to provide a lighted message for a tire display. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the message disclosed

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by Caulkins a lighted message, as taught by Hathorn, in order to more effectively attract the attention of passers-by.

8. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caulkins in view of Pynenburg et al.

Regarding claim 12, Caulkins discloses the invention substantially as claimed, as set forth above. However, the letters in the message disclosed by Caulkins do not appear to be magnetic letters attached to a metal surface. Pynenburg teaches that it was known in the art to provide a metal surface having magnetic letters removably attached thereto. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the message disclosed by Caulkins by mounting a metal plate to the cover and attaching magnetic letters thereto, as taught by Pynenburg, in order to make the message changeable.

Regarding claim 14, Caulkins discloses the invention substantially as claimed, as set forth above. However, the letters in the message disclosed by Caulkins do not appear to be written on a marker surface. Pynenburg teaches that it was known in the art to provide a marker surface and to draw letters thereon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the message disclosed by Caulkins by mounting a marker surface to the cover and drawing letters thereon, as taught by Pynenburg, in order to make the message changeable.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caulkins in view of French.

Caulkins discloses the invention substantially as claimed, as set forth above. However, the message disclosed by Caulkins does not appear to be attached via VELCRO materials.

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French teaches that it was known in the art to provide VELCRO to attach a message to a fabric surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the message disclosed by Caulkins by mounting it to the cover with VELCRO, as taught by French, in order to make the message changeable.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C Hoge whose telephone number is (703) 308-3422. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gary C Hoge
Primary Examiner
Art Unit 3611

gch